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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT 1791	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/552,470	Applicant(s) BARTOLI ET AL.	
	Examiner Kimberly K. McClelland	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. As to claim 1, the phrase, "a minimum coefficient of retroreflection (cd/lx.m²) indicated by European Standard EN 471/1994 (related to high visibility warning clothing) and/or EN 13356/2001 (related to visibility accessories for non-professional use)" is unclear. References to specific standards do not indicate actual retro-reflection values, as these values can change. It is unclear how the current claim language identifies subject matter applicant regards as his invention.
4. Claims 2-13 are rejected due to their dependency on independent claim 1.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

6. Applicant's amendment to the specification dated 7/24/07 has been entered.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 6, and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,416,856 to Crandall in view of U.S. Patent No. 5,620,775 to LaPerre, U.S. Patent No. 5,514,441 to Pohto et al., U.S. Patent No. 6,416,188 to Shusta et al., and U.S. Patent No. 5,620,613 to Olsen.
9. With respect to claim 1, Crandall discloses a method of making a retroreflective article, including providing a carrier sheet with an adhesive on the carrier (column 7, lines 33-38); partially embedding onto the adhesive a monolayer of transparent glass microspheres having a refractive index between about 1.4 and about 2.7 (column 6, lines 1-3); coating a thin layer of a two-component polyurethane resin (column 3, lines 29-44); applying a specularly reflective mirror of aluminum by vacuum deposition; printing a non-etchable pattern onto the aluminum layer (column 6, lines 10-35); applying two layers of dielectric mirror (column 6, lines 36-67); coating a polyurethane binder layer and laminate with a textile base (column 7, line 65-column 8, line 13);

Art Unit: 1791

stripping away the support layer (column 7, lines 61-63). However, Crandall does not disclose embedding onto the adhesive a monolayer of transparent glass microspheres to a depth averaging around 35-40 percent of their average diameters; applying the specularly reflective aluminum over the polyurethane resin; printing a non-etchable pattern onto the aluminum layer; passing said web material through a demetallization bath of sodium hydroxide and a washing station to remove etchable, non-protected surface and drying the web; or applying, by a vacuum process, two layers of dielectric mirror.

10. LaPerre discloses a method of making a glass microsphere coated article, including embedding onto the adhesive a monolayer of transparent glass microspheres to a depth averaging around 35-40 percent of their average diameters (column 4, lines 21-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the range of embedding depths taught by LaPerre in the method of making a retroreflective article disclosed by Crandall. The motivation would have been to enhance the desired texture and appearance to the resulting article (column 3, lines 38-50).

11. Pohto et al. discloses a method of making retroreflective sheeting, including applying the specularly reflective aluminum(14) over the polyurethane resin (13; See Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to applying the polyurethane resin prior to depositing the aluminum layer as taught by Pohto et al. in the method of making a retroreflective article disclosed

Art Unit: 1791

by Crandall. The motivation would have been to provide the desired focal length between the beads and the reflective surface (column 1, lines 38-40).

12. Shusta et al. discloses a method of making retroreflective appliques, including it is known in the art to apply by a vacuum process, two layers of dielectric mirror (column 5, lines 54-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the dielectric mirror coatings of Crandall using the vacuum process taught by Shusta et al. The motivation would have been to create uniform even coatings.

13. Olsen discloses a method of making a transfer sheet, including printing a non-etchable pattern onto the aluminum layer, passing said web material through a demetallization bath of sodium hydroxide and a washing station to remove etchable, non-protected surface and drying the web (column 11, lines 8-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the binding and etching steps taught by Olsen with the method of making a retroreflective article disclosed by Crandall. The motivation would have been to form graphic segments in the retroreflective article, creating a decorative pattern (column 3, lines 32-38).

14. As to claim 2, Crandall discloses the carrier sheet has a heat-softenable adhesive layer on the carrier (column 7, lines 24-28).

15. As to claim 3, Crandall discloses an auto-adhesive layer on a carrier sheet (column 7, lines 24-28). However Crandall does not disclose the carrier sheet is an auto-adhesive layer supported by a polymer backing.

Art Unit: 1791

16. LaPerre discloses a method of making a glass microsphere coated article, including it is known in the art that polymeric films are functional equivalents to paper backings (column 8, lines 34-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the art-recognized equivalent polymer film taught by LaPerre for the paper backing in the method of making a retroreflective article disclosed by Crandall.

17. As to claim 6, Crandall discloses the polyurethane resin used for coating the glass web is a water-dispersion and the curing agent is an aliphatic poly-isocyanate (column 4, lines 33-35).

18. As to claim 8, Crandall does not disclose the transfer image used for printing the coated microspheres is made with a non-etchable resin.

19. Olsen discloses a method of making transfer sheet, including the transfer image used for printing the coated microspheres is made with a non-etchable resin (column 11, lines 34-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the binding and etching steps taught by Olsen with the method of making a retroreflective article disclosed by Crandall. The motivation would have been to form graphic segments in the retroreflective article, creating a decorative pattern (column 3, lines 32-38).

20. As to claim 9, Crandall does not disclose the thermoplastic resin used for the printed base is a polyurethane, a polyamide or a polyacrylic polymer.

21. Olsen discloses a method of making transfer sheets, including the resin is a polyurethane, a polyamide or a polyacrylic polymer (column 7, lines 48-52). It would

Art Unit: 1791

have been obvious to one of ordinary skill in the art at the time the invention was made to combine the binding and etching steps taught by Olsen with the method of making a retroreflective article disclosed by Crandall. The motivation would have been to form graphic segments in the retroreflective article, creating a decorative pattern (column 3, lines 32-38).

22. As to claim 10, Crandall discloses the resin is supported on a base (34) which is a release paper, a polypropylene or polyester foil (column 7, lines 25-30).

23. As to claim 11, Crandall discloses the base (34) a polypropylene printed film (column 7, lines 21-30).

24. As to claim 12, Crandall does not disclose the non-etchable transfer pattern is replaced by a silk-screen printing or roll printing on the reflective aluminum layer.

25. Olsen discloses a method of making transfer sheets, including the non-etchable transfer pattern is replaced by a silk-screen printing or roll printing on the reflective aluminum layer (column 11, lines 1-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the binding and etching steps taught by Olsen with the method of making a retroreflective article disclosed by Crandall. The motivation would have been to form graphic segments in the retroreflective article, creating a decorative pattern (column 3, lines 32-38).

26. As to claim 13, Crandall discloses the transparent dielectric mirror is a layer of aluminum sodium fluoride (NaAlF_6) overlaid by a layer of zinc sulfide (ZnS ; column 7, lines 4-15).

Art Unit: 1791

27. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,416,856 to Crandall in view of U.S. Patent No. 5,620,775 to LaPerre, U.S. Patent No. 5,514,441 to Pohto et al., U.S. Patent No. 6,416,188 to Shusta et al., and U.S. Patent No. 5,620,613 to Olsen as applied to claims 1-3, 6, 8-10, and 12-13 above, and further in view of U.S. Patent No. 6,592,700 to Wang et al.

28. With respect to claim 4, Crandall discloses the polyurethane resin is a reaction product of a polyether polyol having a number molecular weight of at least 2,000 and a polyisocyanate (See Abstract).

29. Wang et al. disclose a method of producing retro-reflective sheets, including polyester polyurethane polyols are functionally equivalent to polyether polyols when producing polyurethane resins (column 2, lines 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the art-recognized equivalent polyester polyol taught by Wang et al. for the polyether polyol disclosed by Crandall.

30. As to claim 7, Crandall discloses the polyurethane resin is a reaction product of a polyether polyol having a number molecular weight of at least 2,000 in solvent and a polyisocyanate (column 10, lines 16-32).

31. Wang et al. disclose a method of producing retro-reflective sheets, including polyester polyurethane polyols are functionally equivalent to polyether polyols and aromatic polyisocyanate is equivalent to isocyanate when producing polyurethane resins (column 2, lines 48-50; column 3, lines 30-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the art-

Art Unit: 1791

recognized equivalent polyester polyurethane polyol and the aromatic isocyanate taught by Wang et al. for the polyether polyol and isocyanate disclosed by Crandall.

32. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,416,856 to Crandall in view of U.S. Patent No. 5,620,775 to LaPerre, U.S. Patent No. 5,514,441 to Pohto et al., U.S. Patent No. 6,416,188 to Shusta et al., U.S. Patent No. 6,355,302 to 5,620,613 to Olsen and further in view of U.S. Patent No. 6,592,700 to Wang et al. as applied to claim 4 above, and further in view of applicant's admitted prior art.

33. With respect to claim 5, Crandall does not disclose the dry polyurethane resin on the glass microspheres is less than about 3 g/sqm of dry substance.

34. Pohto et al. discloses the thickness of the space coat layer is determined as a function of the index of refraction and the average diameter of the microspheres and the index of refraction of the space coat (column 11, lines 10-13). Applicant's admitted prior art discloses it is known to use a polyurethane space coat with a thickness of less than about 3 g/sqm (page 5, lines 6-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the basis weight of 3 g/sqm of polyurethane resin, as disclosed by applicant in the method of Crandall. Pohto et al. discloses this value is determined by routine experimentation given certain parameters of the article. The motivation would have been to obtain the desired focal length of the article (Pohto et al.; column 1, lines 38-40). More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

Art Unit: 1791

optimum or workable ranges by routine experimentation. In re Swain et al., 33 CCPA (Patents) 1250, 156 F.2d 239, 70 USPQ 412; Minnesota Mining and Mfg. Co. v. Coe, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136.

Response to Arguments

35. In light of the current amendment, the rejections of claims 8-12 under 35 U.S.C. 112, second paragraph due to indefinite claim language have been withdrawn.

However, claims 1-13 remain rejected under 35 U.S.C. 112, second paragraph due to the reference to a specific standard. Claims 2-13 are rejected due to their dependency on independent claim 1.

36. Applicant's arguments, see remarks, page 12, lines 7-9, filed 7/24/07, with respect to the rejection(s) of claim(s) 1-13 under 35 U.S.C. 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of newly discovered prior art

37. As to applicant's argument that Vandenberg does not disclose step (e) printing a non-etchable transfer pattern onto the aluminum layer, thereby forming a transfer image or step (f) passing said web material through a demetallization bath of sodium hydroxide and a washing station to remove etchable, non-protected surface and drying the web in the same embodiment, examiner agrees. Consequently, the previous rejections are withdrawn. However, new rejections under 35 U.S.C. 103(a) have been established.

Art Unit: 1791

38. Applicant is reminded one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1791

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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